

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed December 12, 2008. Reconsideration and allowance of the application and pending Claims 1 and 3-20, as well as newly added Claims 45 and 46 are respectfully requested.

Claims 1 and 3-20 are pending in the instant application. Claims 1 and 3-20 have been rejected by the Examiner. Claims 1 and 3 have been amended. Claims 45 and 46 have been added. Applicants submit that Claims 1, 3-20, 45 and 46 are in condition for allowance and respectfully request reconsideration and withdrawal of the outstanding rejections. No new matter has been entered.

Support for the amendments to Claims 1 and 3, as well as newly added Claims 45 and 46, can be found in the application as originally filed. See, for example, paragraph [0022] and FIG. 2.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1 and 3-6 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Daniell et al.* (“*Daniell*,” U.S. Pat. App. No. 2004/0054736) in view of *Collins et al.* (“*Collins*,” U.S. Pat. App. No. 2003/0009595). Applicants respectfully traverse these rejections.

Regarding Claim 1, the Examiner concedes that *Daniell* does not disclose “**transmitting history data along with said instant message**, said history data including communications exchanges previously conducted between said email recipient and said email sender; wherein said communications exchanges include at least one of: email messages; instant messages; and attachments, ” as recited in Claim 1.

The Examiner asserts that *Collins* cures this deficiency, citing “Reply With History” feature, FIGs. 3a and 3b, and paragraphs [0038] – [0040]. Contrary to the Examiner’s assertion, Applicants respectfully submit *Collins* teaches, “[a]s illustrated in FIG. 3b, the text 310 of the initial email message 300 is substantially reproduced in the new email message.” (*Collins*, paragraph [0038]). *Collins* only deals with e-mail messages. There is no teaching in *Collins* of transmitting history data including communications exchanges previously conducted between said email recipient and said email sender **along with said instant message**. As

described in paragraph [0019] of *Collins*, “FIGS. 3 a - c illustrate an exemplary sequence of related email messages.” The Examiner’s motivation to combine the references to “allow a sequence of comments from the individuals in the common group to be tracked from one email message to the next” is insufficient, since this motivation does not provide any rationale as to why one would be motivated to combine the e-mail related teachings of *Collins* with the instant message related teachings of *Daniell*.

Furthermore, Applicants respectfully submit that *Daniell* in view of *Collins* does not teach or suggest, “determining whether said email sender is available to receive said instant message; and in response to determining that said email send is unavailable to receive said instant message and in response to receiving a request from said email sender to defer, storing said instant message and periodically retransmitting said instant message”, as recited in Claim 1.

Accordingly, for at least these reasons Applicants respectfully submit Claim 1 should be allowable since *Daniell* in view of *Collins* fails to teach or suggest all of the elements of Claim 1, and there is insufficient motivation to combine the references.

Since Claims 3-6 depend from Claim 1, Applicants respectfully submit that Claims 3-6 should be allowable for at least the same reason that Claim 1 is allowable.

Further regarding Claim 3, Applicants respectfully submit that *Daniell* in view of *Collins* does not teach or suggest, “in response to determining said email sender is unavailable to receive said instant message and in response to receiving a request from said email sender to send content of said instant message in a response email message, transferring said content of said instant message to an email application resulting in said response email message and transmitting said response email message to said email sender”, as recited in Claim 3. For at least this reason, Claim 3 should be allowable over *Daniell* in view of *Collins*.

Claims 7-12 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Daniell*, in view of *Collins*, and further in view of *Danon* (“*Danon*,” U.S. Pat. App. No. 2003/0110211) and *Davis et al.* (“*Davis*,” U.S. Pat. App. No. 2004/0158610). Applicants respectfully traverse these rejections.

As described in reference to Claim 1, *Daniell* in view of *Collins* does not teach or

suggest multiple elements of Claim 1. The addition of *Danon* and *Davis* does not cure this deficiency. Since Claims 7-12 depend from Claim 1, Applicants respectfully submit that Claims 7-12 should be allowable for at least the same reason that Claim 1 is allowable.

Claim 13 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Daniell*, in view of *Collins*, and further in view of *Danon*. Applicants respectfully traverse these rejections.

As described in reference to Claim 1, *Daniell* in view of *Collins* does not teach or suggest multiple elements of Claim 1. The addition of *Danon* does not cure this deficiency. Since Claim 13 depends from Claim 1, Applicants respectfully submit that Claim 13 should be allowable for at least the same reason that Claim 1 is allowable.

Claims 14-18 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Daniell*, in view of *Collins*, and further in view of *Atencio et al.* (“*Atencio*,” U.S. Pat. App. No. 2004/0210450). Applicants respectfully traverse these rejections.

As described in reference to Claim 1, *Daniell* in view of *Collins* does not teach or suggest multiple elements of Claim 1. The addition of *Atencio* does not cure this deficiency. Since Claims 14-18 depend from Claim 1, Applicants respectfully submit that Claims 14-18 should be allowable for at least the same reason that Claim 1 is allowable.

Claims 19 and 20 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Daniell*, in view of *Collins*, and further in view of *Roskind* (“*Roskind*,” U.S. Pat. App. No. 2004/0128540). Applicants respectfully traverse these rejections.

As described in reference to Claim 1, *Daniell* in view of *Collins* does not teach or suggest multiple elements of Claim 1. The addition of *Roskind* does not cure this deficiency. Since Claims 19 and 20 depend from Claim 1, Applicants respectfully submit that Claims 19 and 20 should be allowable for at least the same reason that Claim 1 is allowable.

Applicants further submit that newly added claims 45 and 46 are also allowable over the cited art.

CONCLUSION

Applicants are not conceding in this application that the original claims are not patentable over the art cited by the Examiner. Rather, the present claim amendments are only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

It is believed that the foregoing remarks are fully responsive to the Office Action and that the claims herein should be allowable to the Applicants. In the event the Examiner has any queries regarding the instantly submitted response, the undersigned respectfully request the courtesy of a telephone conference to discuss any matters in need of attention.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 09-0457.

Respectfully submitted,

CANTOR COLBURN LLP
Applicants' Attorneys

By: /Eric J. Baron/
Eric J. Baron
Registration No. 56,025
Customer No. 77212

Date: March 9, 2009

Address: 20 Church Street, 22nd Floor
Hartford, CT 06103-3207

Telephone: (860) 286-2929

Fax: (860) 286-0115